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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,956

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Stephen J. Nolan

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06/04/2009

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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

06/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,956	Applicant(s) NOLAN ET AL.	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/12/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed 2/12/09 overcomes the rejection set forth under 35 USC 102 in the office action mailed 11/12/08. New ground of rejections are set forth below. The double patenting rejection is maintained.

Double Patenting

2. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 11/557,612. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The rejections of claims 1-20 are adequately set forth in paragraph 2 of the office action mailed 11/12/08, which is incorporated here by reference. Claim 8 of the '612 application discloses that the surfactant can be a polyisobutenyl succinic acid, meeting the limitations of newly added claim 21 of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1797

4. Claims 1, 4-10, and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 18, and their dependent claims, recite the limitation “wherein the metal of the metal hydroxide is present in the range of about 2 to about 16 percent”. It is not clear whether this refers to the concentration of the metal within the dispersion or within the grease composition as a whole. It is the examiner’s opinion that applicant intends for the limitation to refer to the concentration of the metal within the dispersion, and the claims have been examined in this manner below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1797

7. Claims 1, 4-8, 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross.

From column 2 line 57 through column 3 line 2, Cross discloses a grease composition comprising an oil, lithium salt of a fatty acid, which is the reaction product of components (a) and (c) of claim 1, and a surfactant with an HLB between 1 and 6, within the range recited for component (b) of claim 1. The grease of Cross can be therefore be the reaction product of the components recited in claims 1 and 4, which are in product-by-process form. Lithium is an alkali metal as recited in claims 5-6. In column 4 lines 20-22 Cross discloses that the fatty acid is preferably 12-hydroxystearic acid, meeting the limitations of the acids of claims 7-8. The grease further includes a corrosion (rust) preventing composition, meeting the limitations of claim 10.

In column 4 lines 23-25, Cross discloses that the grease preferably comprises from 5 to 15% by weight of the lithium 12-hydroxystearate. Lithium 12-hydroxystearate comprises 2.2% by weight of lithium, so the concentration of lithium in the grease is preferably from 0.11 to 0.33% by weight. The dispersion recited in component (a) of claim 1 provides from 0.01 to 3.20% by weight of metal to the grease composition. The grease of Cross can therefore be made by the process recited in claim 1, with concentrations of dispersion and metal within the dispersion falling within or overlapping the claimed ranges. See MPEP 2144.05(I): "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976);" The preferred concentration of lithium salt also implies an oil concentration within the range

Art Unit: 1797

recited in component (d) of claim 1 and an acid concentration within the range recited for component (c) of claim 1.

As the grease of Cross meets the compositional limitations of claim 18, the process of forming the grease meets the limitations of the claim.

Response to Arguments

8. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797